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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,437	12/14/2003	DAVID LIANG MABBUTT	DMABB05F	1436
33310	7590	03/09/2005	EXAMINER	
EDWIN A. SKOCH II 67 WALL STREET, 22ND FLOOR PMB#0029 NEW YORK, NY 10005-3198			BAXTER, GWENDOLYN WRENN	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/707,437	MABBUTT, DAVID LIANG	
	Examiner Gwendolyn Baxter	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 29 December 2004.  
2a)  This action is FINAL.                  2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-14 is/are pending in the application.  
    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-14 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

This is the second office action for serial number 10/707,437, Improved Mouse pad filed December 14, 2004.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 10, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,125,032 to Gillespie. The present invention reads on Gillespie as follows: Gillespie teaches a mouse pad (28) comprising a mouse pad (28) with one or more connectedly attached members (34, 10) at or near the edge of the mouse pad. The member or members protrude above the surface of the mouse pad in a roughly perpendicular fashion and provide a barrier to discourage mouse movement off that edge of the mouse pad where the member or member is located. See figures 3 and 4. Although a tropical theme is shown, sport themes with artistic indicia relating to baseball or football are encouraged as well (col. 2, lines 64).

Claims 1, 6, 7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by non-patent literature, Information Fairway Mouse Pad, herein after Info Mouse Pad. The present invention reads on Info Mouse Pad as follows: Info Mouse Pad teaches a mouse pad comprising a mouse pad with one or more connectedly attached members (the flag) at or near the edge of the mouse pad. The member or members protrude above the surface of the mouse pad in a roughly perpendicular fashion and provide a barrier to discourage mouse movement

off that edge of the mouse pad where the member or member is located. The member or members are in the shape of a golf hole, post and flag. The mouse pad has the appearance of a full or partial golf green. The flag provides the area necessary for displaying graphics or text used for promotion purposes.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 8, 10, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,125,032 to Gillespie. The present invention reads on Gillespie as follows: Gillespie teaches a mouse pad (28) comprising a mouse pad (28) with one or more connectedly attached members (34, 10) at or near the edge of the mouse pad. The member or members protrude above the surface of the mouse pad in a roughly perpendicular fashion and provide a barrier to discourage mouse movement off that edge of the mouse pad where the member or member is located. See figures 3 and 4. Although a tropical theme is shown, sport themes with artistic indicia relating to baseball or football are encouraged as well (col. 2, lines 64 through col. 3, line 1). Gillespie clearly teaches the anchoring of the member or members to the mouse pad (28) via the pegs (34); however fails to teach the member or members being anchored in the mouse pad. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to have provided the peg on the bottom of the member or member while the mouse pad provided with the openings for receiving the pegs therein, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art as a obvious expedient. *In re Einstein*, 8 USPQ 167.

Regarding claims 2 and 4, Gillespie encourages the changing of themes such as a tropical or sport theme with artistic indicia relating thereto (col. 2, lines 64+). However, Gillespie fails to teach a shape of a hockey goal or basketball post, backboard, and hoop and appearance of a hockey rink or basketball court. It would have been an obvious matter of design choice to shape the mouse pad as a full or partial hockey rink or basket ball court or to make the member or members in the shape of a hockey goal or basketball post, backboard and hoop, since such a modification would have involved a mere change in the shape of components. A change in shape is generally recognized as being within the level of ordinary skill in the art, since the configuration of the claimed mouse pad or member is not significant. Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mouse pad and member or members to have the appearance of hockey goal and partial rink or a basketball post and partial court, since it has been held to be within the general skill of a worker in the art to select a change in aesthetic design as a matter of obvious design choice. *In re Seid*, 73 USPQ 431.

Claims 3, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie in view of U.S. Patent No 5,952,070 to Depiero. Gillespie teaches a mouse pad but does not discuss the use of graphics or text used for promotional purposes on the mouse pad.

Depiero teaches a mouse pad utilizing graphics and indicia for informational purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mouse pad as taught by Gillespie to have incorporated the graphics or text on the mouse pad as taught by Depiero for the purpose of displaying information.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie in view of U.S. Patent No. 5,876,010 to Murphy. Gillespie teaches the limitations of the base claim, excluding surface that can be written on. Murphy teaches a mouse pad having a write able surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mouse pad as taught by Gillespie to have incorporated the writing surface as taught by Murphy for the purpose of providing a mouse pad having a surface that permits writing there on by the user.

#### *Response to Arguments*

Applicant's arguments with respect to claims 1, 2, 4, 8, 10, 11 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues Gillespie teaches only members that are a mouse enclosure. I agree with applicant the structure surface 30 is an enclosure.

Applicant argues Gillespie teaches only decorative alterations to a mouse pad. At column 2, lines 59+, Gillespie teaches the appearance of the individual elements revolving around a fantastical medieval theme containing dragons, castles and gargoyles. However, this is not the only possible theme since computer users have different taste and imagination. This

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is not directed solely to the mouse pad but the computer system display in figure 1. This figure depicts the medieval theme not just the mouse pad.

Applicant argues Gillespie does not teach a barrier or bumper function. Applicant's claim is directly to a barrier and not a bumper. At item one of applicant's argument applicant states "The common definition of the term enclosure denotes confining or surrounding within the confines of the structure itself. The mouse while inside the enclosure cannot be used the mouse may logically be prevented from moving off the edge of the pad while in the enclosure," If the mouse is prevented from moving off the edge of the pad, then the enclosure is acting as a barrier by applicant's own admission.

Lastly, In response to applicant's argument that "Gillespie does not teach the use of a mouse pad as a game or as a sport in miniature", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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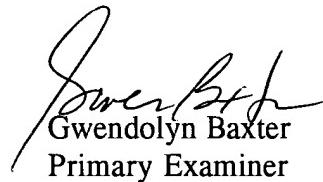
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is 703-308-0702. The examiner can normally be reached on Monday-Wednesday, 8:00am -5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A Braun can be reached on 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gwendolyn Baxter  
Primary Examiner  
Art Unit 3632

March 6, 2005